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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,175	03/14/2005	Shouji Kamiya	2005-0042A	2857

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WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

EXAMINER

SHAMEEM, GOLAM M

ART UNIT	PAPER NUMBER
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1626

MAIL DATE	DELIVERY MODE
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01/14/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/521,175

Applicant(s)

KAMIYA ET AL.

Examiner

Golam M. M. Shameem, Ph.D.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 31 and 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1-30, 33 and 34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>04/25/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

This application claims benefit for foreign priority under 35 U.S.C. § 119(a)-(d) to Japan 2002-208878 07/17/2002, however the certified copy of priority document has not been received or made part of the file. Therefore, any priority claim to this document has not been perfected.

Status of Claims

Claims 1-34 are currently pending in the application.

Receipt is acknowledged of amendment / response filed on June 06, 2007 and that has been entered.

Claims 31 and 32 are withdrawn from further consideration pursuant to 37 C.F.R. 1.142 (b) as being drawn to a non-elected subject matter.

Information Disclosure Statement

Receipt is acknowledged of Information Disclosure Statement (IDS), filed on 04/25/2007, which has been entered in the file.

Response to Election/Restriction

In response to the restriction requirement, Applicants have elected Group I, [which includes claims 1-30, 33 and 34 drawn to a compound of formula (I)] and the elected species as set forth found in Example 46 (Remarks, page 1) is acknowledged. Because Applicants did not distinctly and specifically point out the supposed errors in the restriction requirement, the

election has been treated as an election without traverse [MPEP 818.03(a)] and therefore, the requirement for restriction is still deemed sound and proper.

Applicants preserve their right to file a divisional on the non-elected subject matter.

As set forth in the restriction requirement and an election of a single compound (or set of compounds), the scope of the invention which has been examined, inclusive of the elected species is as follows:

A compound of the formula (I) wherein:

R¹ and R³ are as claimed,

R² is as claimed except “-NO₂”

R⁴ is as claimed except “hydrogen”,

R⁵ is as claimed and

R¹² is as claimed except “hydrogen”.

As a result of the election and the corresponding scope of the compound identified, claims 31 and 32 and the remaining subject matter of claims 1-30, 33 and 34 are withdrawn from further consideration pursuant to 37 CFR 1.142 (b) as being drawn to non-elected inventions. The withdrawn subject matter of claims 31 and 32 is properly restricted as it differs materially in structure and in element from the elected subject matter supra so as to be patentably distinct there from.

Objections

Claims 1-30, 33 and 34 are objected to for containing non-elected subject matter. The claims should be amended to exclude non-elected subject matter and within the scope of elected compound.

The superfluous word "novel" (recited in claim 1, page 5, line 1 and also in all other claims) should be deleted.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Golam Shameem, Ph.D. whose telephone number is (571) 272-0706. The examiner can normally be reached on Monday-Thursday from 6:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached at (571) 272-0699. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone number for this Group is (571) 273-8300.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet

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e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (571) 272-1600.

Golam M M Shameem, Ph.D.
Primary Patent Examiner
Art Unit 1626
Technology Center 1600

A handwritten signature in black ink, appearing to read 'Golam M. M. Shameem', with a stylized, cursive script.

GOLAM M. M. SHAMEEM, PH.D
PRIMARY EXAMINER